



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/966,033

09/28/2001

Joshua R. Smith

103140-0012U1

7207

24267 7590 07/25/2008

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER

CASLER, TRACI

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

07/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/966,033	Applicant(s) SMITH ET AL.	
	Examiner Traci L. Casler	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,20-24 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 20-24 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to papers filed on March 26, 2008.

Claims 2, 4, 20-24 and 28-30 are pending.

Claims 2, 4, 20-23 and 28-30 have been amended.

Claims 1, 2, 5-19, 25-27 and 31-47 have been cancelled or withdrawn.

Claims 2, 4, 20-24 and 28-30 are rejected.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 26, 2008 has been entered.

Claim Rejections - 35 USC § 101

Claims 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2. As to claims 21-24 are directed towards non-statutory subject matter as the claims fail to 1) be tied to another statutory class(such as a particular apparatus) or 2) transform the underlying subject matter(such as article or materials). If neither of these requirements are met by the claim, the method is not a patent eligible process under 35 USC 101 and is non-statutory subject matter. The examiner further notes that a "nominal" tie to another statutory class, such as a computer limitation in the preamble,

will not solve the deficiency. The examiner notes that the applicant claims "providing a graphical user interface for providing access..." however, use the interface is not positively recited therefore the interface is not actively used in the method claims as currently claims. None of the steps of the method positively recite the use of the interface.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 4, 20-24 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2005/0197892 Bilibin et al. Apparatus, System and Method for Zone level rating for each of Multiple Carriers, In view of US Patent 6463420 Guidice et al; Online Tracking of Delivery status information over a computer network. Hereinafter referred to as Bilibin and Guidice respectively.

5. As to claim 2, 4, 20-23 and 28-30 Bilibin teaches:

A. associating respective users with user identifiers (**¶ 162 registering and creating user ID and passwords**)

6. B. associating with the respective users mail pieces directed by others(different carriers) to respective users sent to others by the respective users;(Fig. 56-57) The examiner notes who the mail piece is sent to is does not patentably distinguish itself from the prior art, the tracking would be processed the same regardless of the recipient.

C. linking to the user identifiers to which the mail pieces are associated mail piece delivery status information relating to the respective mail pieces(**Fig. 50 Ref. 441-442**) **Bilibin fails to teach linking the mail piece delivery status with the user Identifier, however Guidice teaches the system identifying if the has submitted orders that can be tracked according to the user ID(C. 6 I. 45-47; I. 55-60).** It would have been obvious to one of ordinary skill in the art at the time of invention to combine the Associating steps of Guidice with the multi-carrier tracking of Bilibin. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

D. receiving information concerning the contents of the respective mail pieces from the senders of the respective mail pieces and linking to the de\- livery status information an attachment consisting of the information concerning the contents of the respective mail pieces; and (**Fig. 51-54**). Although Bilibin fails to teach the specific type of format of information that is sent to the (i.e. Text information, graphics, audio etc) these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the noises or pictures presented. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

E. providing a graphical interface configured for entering user identifiers and providing access to::l(Pg. 8 ¶ 147) Fig 54 Ref. 1258)

- i. provide the mail piece delivery status information that is linked to the user identifiers that are associated with the respective users, and
- ii. provide to the respective users the associated information concerning the contents of the respective mail pieces. (Fig. 71-72)

7. **Bilibin fails to teach the user accessing the above information by entering user identifiers. However, Guidice teaches the user entering the ID and Password in order to be able to select the order for which the user wishes to track(C. 6 I. 45)**

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the accessing steps of Guidice with the multi-carrier tracking of Bilibin. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

8. As to claim 24 Bilibin teaches the one or more messages being "provided" by the sender associated with the mail piece.(Fig. 51).

Response to Arguments

9. Applicant's arguments with respect to claims 2, 4, 20-24 and 28-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/
Primary Examiner, Art Unit 3629